

REMARKS:Status

After this response, claims 1 to 5, 8 to 16, 18, and 19 are pending. Claims 1 and 15 are the independent claims and have been amended. Claims 5 and 16 have been amended as well. Entry of this response, reconsideration and further examination are respectfully requested.

Drawings

Drawings 7 to 29 have been canceled, rendering the objections thereto moot.

Specification

References to the canceled drawings have been deleted from the specification.

Claim Rejections

Claims 1 to 7 and 15 to 17 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 4,741,537 (Adam). Claims 8 to 10, 18, and 19 were rejected under 35 U.S.C. § 103(a) over Adam in view of U.S. Patent Pub. No. 2003/0162598 (Eckardt). Claims 11 to 13 were rejected under § 103(a) over Adam in view of U.S. Patent No. 4,779,796 (Lai). Claim 14 was rejected under § 103(a) over Adam in view of Lai and U.S. Patent No. 3,693,979 (Koett).

Claims 1 to 5 and 8 to 14: Claim 1 is the independent one of these claims and is reproduced below as amended:

1. An automatic tee-up device, comprising:
 - a golf ball reservoir;
 - a platform with a groove for a golf ball to travel from the reservoir to a tee, with the tee movable from below a level of the golf ball in the groove to above the level of the golf ball in the groove; and
 - a ball ejector disposed to eject golf balls one at a time from the reservoir onto the groove;
 - a lever that projects from the platform and that actuates the ball ejector and the tee;
 - wherein after the golf ball is ejected by the ejector, the golf ball travels on the groove to the tee and is raised by the tee into a position suitable for striking with a golf club;
 - wherein the ball ejector and the tee are actuated by moving an end of the lever in a horizontal arc; and
 - wherein the lever is disposed to be actuated by a head of the golf club.

The applied art, alone or in combination, is not seen by Applicant to disclose or to suggest the foregoing features of claim 1, at least with respect to the feature that “the ball ejector and the tee are actuated by moving an end of the lever in a horizontal arc”

In this regard, Adam at col. 3, lines 40 to 44, and Figs. 1, 3, and 6 was cited as teaching this feature. This portion of Adam states the following:

The feeder means of the present invention are shown generally at 6. They include a pedal 7 which the golfer *depresses* with his club head when he wishes to have a ball sent by the feeder means to the teeing means.

(Emphasis added.) However, the pedal clearly does not move in a *horizontal* arc. Rather, as clearly shown in the figures, the pedal moves in a vertical arc when depressed.

This difference is significant. Applicant has found that moving an end of a lever in a *horizontal* arc with a club head is a very simple and non-disruptive action. Applicant submits that a

golfer's physical experience would be entirely different between depressing a pedal with a golf club and moving an end of a lever in a horizontal arc.

None of the remaining applied references is seen to add anything that remedies the foregoing deficiency of Adam. Accordingly, claim 1 and its dependent claims are believed to be allowable over the applied art. Such action is respectfully requested.

Claims 15, 16, 18, and 19: Claim 15 is the independent one of these claims. That claim has been amended to recite the subject matter of claim 17, which has been canceled. Claim 15 as amended is reproduced below:

15. A method of using an automatic tee-up device, comprising the steps of:
 - actuating a lever to cause a ball ejector to eject golf balls one at a time from a golf ball reservoir onto a platform with a groove for a golf ball to travel from the reservoir to a tee; and
 - actuating the lever to cause the tee to raise the golf ball, with the tee movable from below a level of the golf ball in the groove to above the level of the golf ball in the groove;
 - wherein after the golf ball is ejected by the ejector, the golf ball travels on the groove to the tee and is raised by the tee into a position suitable for striking with a golf club;
 - wherein an end of the lever is actuated by being moved in a horizontal arc and is disposed to be actuated by a head of the golf club.

This claim now recites that an end of the lever that actuates the ball ejector and the tee is actuated by being moved in a horizontal arc. Substantially as discussed above, the applied art, alone or in combination, is not seen by Applicant to teach such. Accordingly, claim 15 and its dependent claims also are believed to be allowable over the applied art. Such action is respectfully requested.

Certain Dependent Claims: Turning to claims 5, 16, 10, and 19, the applied art also does not disclose or suggest the features of these claims.

Claim 5 recites that “the ball ejector operates in conjunction with an agitating block within the golf ball reservoir so as to eject the golf balls one at a time and so as to agitate golf balls in the reservoir.” The Office Action responds that “[t]he [E]xaminer interprets the outside of the storage means [in Adam] to be an agitating block because the outside of the storage means directs the golf balls down a spiraling tubing (10) via gravity. The movement of the golf balls along this path are agitated or moved.”

While the balls in Adam’s reservoir might be agitated or moved along the path, Adams does not disclose a block that actually does this agitating. Hence, Adams does not disclose an “agitating block.” Furthermore, without this block, balls moved only by gravity might very well become jammed within a reservoir. Thus, gravity is not a substitute for an actual agitating block.

Applicant has also amended claim 5 to clarify that the agitating block is “within the golf ball reservoir.” Thus, the golf ball reservoir cannot be the agitating block as claimed.

Similar arguments apply to claim 16, which also recites that “an agitating block within the golf ball reservoir” agitates “golf balls in the reservoir.”

None of the remaining applied references is seen to add anything that remedies the foregoing deficiency of Adam.

Turning to claim 10 and 19, Eckardt was cited as teaching the scale recited by these claims. However, the Office Action admits that “Eckardt does not explicitly disclose a scale adjacent the lever corresponding to tee heights.” In fact, Eckardt does not even disclose a scale, let alone positioning of the scale “adjacent the lever corresponding to tee heights.”

The Office Action states that “it would have been obvious to do so at the time of Applicant’s invention because it would allow a golfer to adjust the tee to a desired height without the need to experiment to find the desired height.” However, the Office Action does not offer any teaching, disclosure, or even hint that this problem was even recognized in the applied art. As stated by MPEP § 2141.02(III),

[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). However, "discovery of the cause of a problem . . . does not always result in a patentable invention. . . . [A] different situation exists where the solution is obvious from prior art which contains the same solution for a similar problem." *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (emphasis in original).

In this case, the applied art does not even disclose the existence of the problem, let alone its source or another solution for the problem. Rather, the only possible source for the rationale offered in the Office Action appears to be Applicant’s own disclosure, not only for the existence of the problem, but also for use of a scale in this context and combination of the scale with the other elements as claimed to address the problem.

For at least the foregoing reasons, claims 5, 16, 10, and 19 are believed to be allowable over and above their base claims. Such action is respectfully requested.

No Admission

Applicant's decision not to argue each of the dependent claims separately is not an admission that the subject matter of those claims is disclosed or suggested by the applied art.

Closing

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Respectfully submitted,

A handwritten signature in black ink that reads "Dane C. Butzer". The signature is fluid and cursive, with the first name "Dane" being the most prominent.

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